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10/738,430

12/17/2003

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EXAMINER

BALAOING, ARIEL A

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/738,430

Applicant(s)

LIN, YI YEN

Examiner

Ariel Balaoing

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The substitute specification filed 04/04/2007 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: a substitute specification, excluding the claims, must be accompanied by a statement that the substitute specification includes no new matter.

Drawings

2. The drawings were received on 04/04/2007. These drawings are acceptable.

Response to Arguments

3. Applicant's arguments filed 04/04/2007 with regards to claims 1-4, 6-11, 13-19 have been fully considered but they are not persuasive.

4. In response to applicant's argument that *the modification proposed in the rejections would change the principle of operation of the prior art invention being modified* (page 10 of the remarks), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

5. In response to applicant's arguments against the references individually (see page 11 of the remarks), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

SAKAGUCHI teaches all the limitations of claim 1 and 10 except SAKAGUCHI does not expressly disclose a sliding holder. The holder of SAKGUCHI comprises a pivoting holder which slides to lock/unlock the holder from the body and then pivots between a first position overlapping a concave portion and second position not overlapping the concave portion. LEARMONTH shows a sliding holder slidable between a first overlapping a concave portion and second position not overlapping a concave portion. Therefore the combination of SAKGUCHI and LEARMONTH disclose the limitations of claim 1 and 10.

6. Applicant's arguments, see pages 13-14 of the remarks, filed 04/04/2007, with respect to Claims 20 and 21 have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejections of Claims 20 and 21 have been withdrawn.

Allowable Subject Matter

7. Claims 20-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 20 and 21 are allowed in view of Applicant's remarks filed 04/04/2007. The combination of SAKAGUCHI and LEARMONTH fail to teach wherein the abutting surface is between the first concave portion and the second concave

portion of the device. While ITO discloses an elastic member and abutting surface, elastic force from the elastic member does not return the holder from a second position to a first position as defined in the claims. Furthermore, interaction between the elastic member of ITO (leaf spring) and that of the combination of SAKAGUCHI and LEARMONTH (elasticity of the cover) differ in the interaction with other elements of the claims and therefore when combined do not disclose the claimed limitations.

Regarding claim 22 and 23, the prior art of record does not disclose wherein the sliding holder comprises an inclined surface, wherein an obtuse angle is formed between the inclined surface and the first concave portion, and the SIM card is abutted by the inclined surface of the holder so that the holder is slid to the second position from the first position so as not to overlap the body during the disposition of the SIM card on the body.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over SAKAGUCHI et al (US 2002/0094841 A1) in view of LEARMONTH et al (US 6,075,706).

Regarding claim 1, SAKAGUCHI discloses a mobile phone with a SIM card holder (Figure 1a; abstract) comprising: a body including a first concave portion and a second concave portion (Figure 1b; paragraph 27); a holder disposed in the first

concave portion of the body the holder movable between a first position overlapping the second concave portion and a second position (3, 4-Figure 1a, 1b; paragraph 27-29); and a SIM card removably disposable in the second concave portion of the body (1-Figure 1a, 1b; abstract), wherein the SIM card is abutted by the holder so that the holder is moved to the second position from the first position during the disposition of the SIM card is disposed in the second concave (abstract; paragraph 27-29), and the holder returns from the second position to the first position so as to fix the SIM card in the second concave portion when the SIM card is located in the second concave portion (abstract; paragraph 27-29). However, SAKAGUCHI does not disclose a sliding holder slidable between a first position overlapping a concave portion and a second position not overlapping a concave portion. In the same field of the endeavor, LEARMONTH discloses a sliding holder **26, 326** slidable between a first position overlapping a concave portion and a second position not overlapping a concave portion (Figures 1, 2, 10; col. 1, line 29-58; col. 3, line 49-col. 4, line 9; col. 5, line 36-41). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SAKAGUCHI to include the latching SIM card holder of LEARMONTH, since the use of a slidable cover used to hold components within portable electronics is well known and conventional in the art. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. See *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the body

includes a first contact in the second concave portion (2-Figure 1a; abstract), and the SIM card includes a second contact corresponding to the first contact (abstract), whereby the SIM card is electrically connected to the body by the second contact contacting the first contact (abstract).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the first contact is an elastic member (2-Figure 1a; abstract), and the SIM card is ejected from the second concave portion by the first contact when the holder is moved to the second position from the first position (abstract; paragraph 26-29; SIM card is elastically held to second concave by the holder, and can be released by moving the holder. The elastic contacts provided for the SIM card will inherently eject the card from the holder when pressure is relieved.).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the depth of the first concave portion is shallower than that of the second concave portion (Figure 1a; 1b; First concave portion is shallower than the second with respect to the mobile devices body).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the body includes an abutting surface between the first concave portion and the second concave portion, and the holder includes an elastic portion corresponding to the abutting surface, whereby the holder is disposed in the first concave portion of the body in a moveable

manner by the elastic portion abutting the abutting surface (paragraph 29-31; Figure 3c).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the holder includes an inclined surface opposite to a surface formed with the elastic portion (paragraph 29-31; Figure 3c; inclined surface provides pressure on the sim).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the holder includes an inclined surface, and the inclined surface is abutted by the SIM card during the disposition of the SIM card in the second concave portion (paragraph 29-31; Figure 3c; inclined surface provides pressure on the sim).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the holder includes a release hole to assist in the movement of the holder (paragraph 29).

Regarding claim 10, SAKAGUCHI discloses a mobile phone with a SIM card holder (Figure 1a; abstract) comprising: a body (Figure 1a, 1b); a holder disposed on the body, the holder movable between a first position and a second position (3, 4-Figure 1a, 1b; paragraph 27-29); and a SIM card removably disposed on the body (1-Figure 1a, 1b; abstract), wherein the SIM card is abutted by the holder so that the holder is moved to the second position from the first position when the SIM card is disposed on the body (abstract; paragraph 27-29), and the holder returns from the second position to the first position to overlap the SIM card so as to fix the SIM card on the body when the

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SIM card is located on the body (abstract; paragraph 27-29). However, SAKAGUCHI does not disclose a sliding holder slidable between a first position overlapping a concave portion and a second position not overlapping a concave portion. In the same field of the endeavor, LEARMONTH discloses a sliding holder **26, 326** slidable between a first position overlapping a concave portion and a second position not overlapping a concave portion (Figures 1, 2, 10; col. 1, line 29-58; col. 3, line 49-col. 4, line 9; col. 5, line 36-41). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SAKAGUCHI to include the latching SIM card holder of LEARMONTH, since the use of a slidable cover used to hold components within portable electronics is well known and conventional in the art. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *See Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the body includes a first concave portion, and the holder is disposed therein (Figure 1a, 1b; paragraph 27-29).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the body includes a second concave portion for receiving the SIM card to dispose therein, and the depth of the first concave portion is shallower than that of the second concave portion (Figure 1a, 1b; paragraph 26-29; First concave portion is shallower than the second with respect to the mobile devices body).

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the body includes a first contact in the second concave portion, and the SIM card includes a second contact corresponding to the first contact, whereby the SIM card is electrically connected to the body by the second contact contacting the first contact (2-Figure 1a; abstract).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the first contact is an elastic member, and the SIM card is ejected from the second concave portion by the first contact when the holder is moved to the second position from the first position (abstract; paragraph 26-29; SIM card is elastically held to second concave by the holder, and can be released by moving the holder. The elastic contacts provided for the SIM card will inherently eject the card from the holder when pressure is relieved).

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the body includes an abutting surface between the first concave portion and the second concave portion, and the holder includes an elastic portion corresponding to the abutting surface, whereby the holder is disposed in the first concave portion of the body in a moveable manner by the elastic portion abutting the abutting surface (paragraph 29-31; Figure 3c).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the holder

includes an inclined surface opposite to a surface formed with the elastic portion (paragraph 29-31; Figure 3c; inclined surface provides pressure on the sim).

Regarding claim 18, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the holder includes an inclined surface, and the inclined surface is abutted by the SIM card when the SIM is disposed on the body from the outside (paragraph 29-31; Figure 3c; inclined surface provides pressure on the sim).

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. SAKAGUCHI further discloses wherein the holder includes a release hole to assist in the movement of the holder (paragraph 29).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AB



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